

Remarks

The Examiner has rejected claims 1-4, 6, 7, 9, 12, 15-27 and 32 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,031,471 (Stefik et al.) in view of U.S. Patent No. 6,389,848 (Kirikoshi et al.).

The examiner has submitted that “Stefik et al fails to teach a mark containing data unique to each page of the printed digital file” but that “Kirikoshi et al teaches a mark containing data unique to each page of the printed digital file (page identification mark printed around the binding margin at the top end of [sic] the book) (col. 9, lines 6-32). *(It is being interpreted by the examiner that the page identification numbers would be unique and different for each page of the book since they are identifying each of the different pages).*” (Official Action 12/12/08, p. 3) (italics in original). The examiner then concludes that “it would have been obvious . . . to have combined the teachings of Stefik with the teaching of Kirikoshi to embed the document with unique watermarks to ensure the authenticity of the printed document and for security purposes.” (Id.) Applicant disagrees.

Stefik et al. discloses that “Glyph watermarks to carry document identification can be embedded by the publisher; while glyphs carrying data about a print event can be added to the watermark at the time of printing by a printing system” and that the information contained in the mark may include “names, locations, and current date and time.” (Col. 10, Ins. 24-31; Col. 12, Ins. 62-65). Accordingly, Stefik et al. provides a system that may to an extent, seek to prevent unauthorized copying and/or alteration of a printed document. However, the watermark taught in Stefik et al. is identical from page to page such that only one mark need be copied and applied to each page to defeat the system taught in Stefik et al. This is the same type of system identified in the Background section of the application at ¶¶8-11.

On the other hand, Kirikoshi et al. teaches that it is “an object of the present invention to provide an information processing system, including an information processing apparatus for executing a program (program for game, for example) by reading the program recorded in a recording medium, such as a CD-ROM, and a peripheral apparatus connected to the information processing apparatus, wherein the information processing system has a security system which effectively prevents execution of a game using an unauthorized CD-ROM or another medium.” (Col. 1, Ins. 39-49). Accordingly, Kirikoshi et al. has nothing to do with secure document printing. Rather, Kirikoshi et al. is directed toward a system for ensuring that a computer program (e.g., a computer game) may only be played if it is an authorized copy of the game.

One of the security means that Kirikoshi et al. uses is a page detection apparatus, where the system scans for a particular page number (e.g., a bar code) on a top inside portion of a page. (Col. 8, Ins. 21-29). If the bar code matches the code in the system memory, then the user can play the game. Accordingly, Kirikoshi et al. is not interested in preventing the unauthorized copying and/or alteration of documents.

While the examiner has submitted that it would be obvious to modify Stefik et al. with Kirikoshi et al. to arrive at the presently claimed invention. Applicant respectfully disagrees. Adding the bar code of Kirikoshi et al. to the watermark of Stefik et al. would not help prevent unauthorized copying and/or alteration of a document because the bar code provided on each page of the document can easily be copied to another page (i.e. an individual could simply copy the entire book taught in Kirikoshi et al. and use that book in place of the original). In other words, the page numbers in Kirikoshi et al. are not provided to prevent unauthorized copying of the page, but rather to ensure that the number listed thereon matches a number in memory so a user can play the game.

Alternatively, if the examiner is arguing that the watermark taught in Stefik et al. is provided to prevent unauthorized copying and/or alternation of a printed page and the various page numbering in Kirikoshi et al. is relied upon to teach that the watermark it-

self could be altered from page to page, the examiner has to point to some fact on the record that shows such a modification of Stefik et al. would be “obvious.” It is clear that Stefik et al. does not teach that having a security mark having data unique to each page would prevent unauthorized copying and/or alternation of a printed document. Likewise, Kirikoshi et al. is not directed toward a system to prevent unauthorized copying and/or alternation of a printed document.

Applicant is sure the examiner is well aware that obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. Neither of the cited references teaches that varying a security mark from page to page will “ensure the authenticity of the printed document and for security purposes.” Rather, it appears that the examiner is using the presently pending application as a roadmap to select unrelated features from divergent references in generating an obviousness rejection, which is improper. See e.g. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (It is well settled that it is impermissible to assemble the prior art using the pending claims as a roadmap to select various features from the prior art where there is no motivation for doing so).

The presently pending claims provides a new approach to secure document printing not contemplated by any of the cited prior art references, namely, to generate a security mark that include data unique to each page of the document. This provides the benefits listed in the written specification of “a document security system that will watermark each page as it prints so as to indicate whether unauthorized printing, alteration or duplication of a document has occurred. The watermark being provided such that it

cannot be accurately copied or counterfeited, and containing machine readable encoded data unique to each page.” (¶12). None of the cited prior art contemplates or teaches this type of system.

It is respectfully submitted that claims 1-28, 30 and 32, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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